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EXAMINER

MEISLAHN, DOUGLAS J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2137

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/631,893

Applicant(s)

LINCOLN ET AL.

Examiner

Douglas J. Meislahn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2, 5, and 6</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
The clause regarding "willful false statements ..." required by 37 CFR 1.68 has been omitted.

The declaration includes a comma in the "original inventor" clause after "I believe". This inclusion is atypical. Please delete the comma in the replacement declaration.

Specification

2. The abstract of the disclosure is objected to because the first clause is not a sentence. Correction is required. See MPEP § 608.01(b).
3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.
4. The disclosure is objected to because of the following informalities: in the title, "information based" should be hyphenated.

Appropriate correction is required.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

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Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 23-49 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 23-49 of copending Application No. 10/238950. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 23, 26, 31, 35, 41, 47-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 50-68 of copending Application No. 10/238950. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application include the material from claims in the copending application and different phrasings in the two sets of claims read on each other. This is a

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provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 1 recites the limitation "the number" in the second to last line. There is insufficient antecedent basis for this limitation in the claim. The claim has referred to a "numbered digital certificate". While this limitation could be interpreted as the information of a digital certificate combined with a number, the examiner is examining the claim as though the limitation means that the information of the digital certificate is numerical. The first mention of a "numbered digital certificate" occurs in line 6 of page 3 and is consistent with this interpretation. Digital certificates are generally used in digital systems, where all information is represented as a number. The examiner recommends deleting "numbered" in line 3 of claim 1 and all future recitations and "the number on" in the fourth line of claim 1.

12. Claim 4 recites the limitation "the nonce number" in its second line. There is insufficient antecedent basis for this limitation in the claim. Delete "number".

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-5, 7, 14-21, 23-27, and 29-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Leon (6424954).

In figure 9, Leon shows a postage stamp that includes an indicium, potential contents of which are described in Table 3 in column 42. As detailed in lines 4-12 of column 42, the indicium can include, among other things, the device ID. As further described in lines 53-55 of column 41, the indicium can include the time at which the indicium is created. Both the device ID and time of creation read on a nonce. Applicant's intent is apparently that the nonce be a nonce symbol. The time of creation is nonce and thus reads on a nonce symbol. The digital signature, which is included in the bar code data, reads on applicant's digital certificate. See also figure 5E-2, which has, in element 5184, a signed message that includes the indicium. As this relates to claim 1, the stamp in figure 9 is a nonce stamp, with some of the printed material, such as a time of creation (which is not shown in figure 9), serving as a nonce symbol. The digital is encoded on the stamp. According to lines 37-45 of column 42, the stamp is used to determine the authenticity of postage. This determination requires that the stamp be presented. As such, the first and second clauses are anticipated. The third clause is anticipated because the signature is based on the indicium.

As shown by table 3, the nonce is included in a barcode, thereby anticipating claims 2 and 24. With respect to claims 3 and 25, the stamp is a physical medium. The barcode, element 914, is a 2-D barcode, meeting the limitations of claims 4 and 26.

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Digital signatures are created using encryption, and thus claims 5 and 27 are anticipated. Claim 7 is anticipated because digital signatures are understood to be decrypted for verification. The SMD in Leon ('54) is a secure device that reads on applicant's tamper-resistant module (see the abstract) and thus claim 14. Figures 5D and 5D-2 disclose communicating with a remote vendor (system server) to update funding, thus anticipating claims 15 and 16. As displayed in table 3, the postage amount, or in applicant's language the purchase price, is included in the digital signature, thus meeting the limitations of claims 17 and 29. Claims 18-21 and 30-33 are anticipated by the nonce and digital certificate since they are embodied on the same stamp, which is placed on a letter. The postage value, which can be the entirety of the nonce, is human-readable. Figure 1b makes apparent that the stamp can be printed on a normal computer. Figure 9 has an indicium that includes neither addressee nor date of mailing (see lines 13-19 of column 40 and note that addressee is not required).

14. Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Sudia (5799086).

In figure 22, Sudia shows a device owner's certificate. The device corresponds to applicant's forgery-resistant physical article and bears a serial number, as shown by element 221. The certificate is signed by the manufacturer, as detailed in lines 46-65 of column 41, and can be used to authenticate the serial number.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 6, 22, 28, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon in view of Ogg et al. (US 2002/0178354).

Leon shows a stamp that has imprinted upon it a number and a digital signature related to that number. With respect to claims 6 and 28, he does not say that the two are checked against each other by encrypting the number. In the paragraph spanning the two columns on page 2, Ogg et al. teach using hashing algorithms, such as SHA-1, to sign a postage indicium. This signature can only be checked by hashing the original data because hashing functions like SHA-1 are irreversible. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a hashing algorithm, as taught by Ogg et al., to sign material in Leon; the stamp would be authenticated by hashing the nonce and comparing with the digital certificate.

With regard to claims 22 and 34, Leon teaches the creation of stamps, not tickets. But, in the first full paragraph of the first column on page 2, Ogg et al. teach that the techniques applied to one value-bearing item, such as stamps, are applicable to other value-bearing items, such as tickets. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Leon's stamp creation method to tickets, as taught by Ogg et al., thereby protecting tickets from fraud.

17. Claims 8-13, 35-45, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon (6424954) in view of Leon (US 2001/0042052 A1).

From line 9 of column 40 through line 57 of column 42, Leon ('54) teaches signing data that is represented on the front of a stamp in order to protect against fraud. Leon ('54) does not teach receiving a nonce from a nonce stamp. In paragraphs 0123 through 0128, Leon ('52) teaches using pre-printed serial numbers on adhesive labels that are to be used as stamps. The pre-printed serial numbers protect against fraud. To be used for security purposes, the serial number is received. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the serial number of Leon ('52) with the signed data of Leon ('54), thereby adding another protection against fraud that is immediately verifiable. This process would require that the serial number be encrypted (in the signing process) and a certificate be provided to the stamp, as shown in figure 5E-2 of Leon ('54).

With respect to claim 36, the stamp is getting an amount of postage and, as shown in the abstract of Leon ('54), the system accounts (charges) for the postage. Figure 5E-2 shows the revenue being charged prior to delivery of the signed indicium, thereby rendering claim 37 obvious. Figure 1 and the abstract of Leon ('52) show a user communicating with a vendor over the Internet, thereby obviating claims 8-13 and 38-40. Element 112-2 of Leon ('52)'s first figure meets the limitations of claim 41. The SMD in Leon ('54) is a secure device that reads on applicant's tamper-resistant module (see the abstract) and thus claims 42 and 43. Figures 5D and 5D-2 disclose communicating with a remote vendor (system server) to update funding, thus rendering obvious claim 44. Claim 45 is anticipated by either Leon reference, both of which teach creating a postage stamp used to mail a letter.

With respect to claim 47, the pre-printed label in Leon ('52) is a forgery-resistant physical article while its serial number is an identification number. Leon ('54)'s method teaches claim 47's digital certificate that authenticates the identification number. Claim 48 is met because the serial number is readable. Claim 49 is met because the barcode in Leon ('54) includes all pertinent information; thus it would be obvious to include the serial number, which is relevant to authentication.

18. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leon ('54) and Leon ('52) as applied to claim 35 above, and further in view of Ogg et al.

The two Leons show a label pre-printed with a serial number that has printed thereupon a digital signature that includes the serial number. They say that the resulting label is used as a stamp, not a ticket. In the first full paragraph of the first column on page 2, Ogg et al. teach that the techniques applied to one value-bearing item, such as stamps, are applicable to other value-bearing items, such as tickets. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Leon's stamp creation method to tickets, as taught by Ogg et al., thereby protecting tickets from fraud.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pauschinger (6523014) – see invention summary; Cordery et al. (6480831) – second paragraph of background; Doljack (6442276) – general use of random and deterministic numbers for security, see especially figure 3; Micali (6292893)

– note 1 in column 5; Goldberg et al. (5848401) – entire document, early pre-printed serial numbers on pre-stamps; Morgan (5560657) – general label security.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Douglas J. Meislahn
Examiner
Art Unit 2137

DJM